

REMARKS

Claims Rejections - 35 U.S.C. §103(a) - Claims 1-138

Claims 1-138 are pending in the present application and were rejected in the Office Action dated July 18, 2003, under 35 U.S.C. §103(a) as being unpatentable in view of Raven et al. (U.S. Patent No. 5,429,361). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 1, 16, 41-43, 68, 69, 83, 84, 100-102, 114, and 135-138 have been amended. The remainder of the claims are dependent claims and, as such, depend from their respective independent claims. For brevity, only the bases for the rejection of the independent claims are traversed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

Specifically, none of cited prior art references teach or suggest the claimed limitation, as amended, of a “systems interface [that] utilizes the gaming platform to produce enhanced system request capabilities and enable interactions with the system network that are not limited to discrete keypad type inputs for system requests.” These capabilities are made possible by the unique abilities derived from the gaming platform used in conjunction with the systems interface. In the cited prior art references, all of the identified systems interfaces (i.e., devices for interfacing with a system network to access “non-gaming” system-type functions) have not been incorporated into the gaming platform of a gaming device. As a result, these systems interfaces have (1) not been able to produce enhanced system request capabilities and (2) have been limited to discrete keypad type inputs for system requests to a system network. This is a clear limitation of the prior art that has been overcome by the claimed invention of the present application.

The Examiner has taken the position that it would be obvious to integrate gaming and system services into a single display system. The Examiner has cited MPEP § 2144.04 as well as the case of *In re Larson*, 340 F.2d 965, 968; 144 USPQ 347, 349 (CCPA 1965), in support of this “obvious to integrate” position.

1. **MPEP § 2144.04 Does Not Allow The Use Of Case Law To Support An Obviousness Rejection Once The Criticality Of A Specific Limitation Has Been Demonstrated**

Applicants respectfully point out that MPEP 2144.04 begins as follows:

**2144.04 Legal Precedent as Source of Supporting Rationale**

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. **If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.**

(emphasis added).

Therefore, once the Applicants have demonstrated the criticality of a specific limitation, it is no longer permissible for an Examiner to rely solely on examples in case law (which are listed in MPEP § 2144.04) to support an obviousness rejection. Accordingly, since the Applicants have explained how the claim limitation of the systems interface utilizes the gaming platform to produce “enhanced system request capabilities and enable interactions with the system network that are not limited to discrete keypad type inputs for system requests,” the Examiner can no longer rely on *In re Larson*, as sole support for his “obvious to integrate” position.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 supports the Applicants’ position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

2. **The Facts Of *Schenck V. Nortron Corp.*, In Which The Court Found The Claims To Be Patentable, Are More Analogous To The Current Situation Than The Facts Of *In Re Larson***

Referring now to MPEP § 2144.04 (V)(B), in the case of *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), the claims were directed to a vibratory testing machine

(a hard-bearing wheel balancer). The vibratory testing machine included a holding structure, a base structure, and a supporting means that form “a single integral and gaplessly continuous piece.” The opponent of the patentee argued that the patentee’s invention just made integral what had been previously made in four bolted pieces. However, the court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance. The inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

As such, Applicants posit that *Schenck v. Nortron Corp.* is far more relevant than *In re Larson*, in which “a brake drum integral with clamping means” was found not to be patentably distinct from the prior art, where a brake disc and clamp were comprised of several parts but rigidly secured together as a single unit. In the case of *In re Larson*, there was no perceived benefit of rigidly securing several parts into a single unit; and thus, there was no patentability distinct invention. However, in *Schenck v. Nortron Corp.*, there was a benefit to combining the supporting means into “a single integral and gaplessly continuous piece.” That benefit was the elimination of the need for a dampening system. In the claimed invention of the present application, the incorporation of a systems interface into the display screen of the gaming platform, and the utilization of the gaming platform by the systems interface, results in the benefits of (1) enhanced system request capabilities and (2) enabling interactions with the system network that are not limited to discrete keypad type inputs for system requests. Therefore, the claimed invention of the present application clearly shows a distinct benefit, as did the claimed invention in *Schenck v. Nortron Corp.*, and thus, the claimed invention of the present application is patentability distinct over the prior art.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 (V)(B) supports the Applicants’ position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

3. **According to MPEP § 2144.04 (II)(B), Omission of an Element with Retention of the Element's Function Is an Indicia of Unobviousness**

Applicants note that MPEP § 2144.04 (II)(B) clearly states that the omission of an element and retention of its function is an indicia of *unobviousness*. Referring now to MPEP § 2144.04 (II)(B), in the case of *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966), the claims at issue were directed to a printed sheet having a thin layer of erasable metal bonded directly to the sheet. The thin layer obscured the original print until it was removed by erasure. The prior art disclosed a similar printed sheet that also included an intermediate transparent layer and erasure-proof protecting layer that prevented erasure of the printing when the top layer was erased. The claims were found to be unobvious over the prior art because (1) the transparent layer in the prior art was eliminated, and (2) the function of the transparent layer was retained (since appellant's metal layer could be erased without erasing the printed indicia.).

Analogously, in the claimed invention of the present application, external system components (such as an external 2-line VF display and an external keypad) have been eliminated, while their functions have been retained. Indeed, as discussed in Section 2 above, not only have their functions been retained, their functions have been enhanced. Using the claimed invention, the system network is able to send system information, in an enhanced format, to a player or employee through the gaming platform to the systems interface, which is in the display screen of the gaming device itself. As a result, the need for the external 2-line VF display has been eliminated, while associated functionality has not only been maintained, it has actually been enhanced. In a similar manner, incorporating the systems interface (1) into the display screen and (2) through the gaming platform has eliminated the need for the external keypad, while its associated functionality has not only been maintained, it has actually been enhanced.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 (II)(B) supports the Applicants' position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over *Raven et al.* has been overcome.

**4. Telephonic Interview of May 18, 2004**

Applicants' representative and the Examiner conducted a telephonic interview on May 18, 2004, regarding the outstanding Office Action. During this telephonic interview the Applicants' representative proposed arguments and amendments that were intended to clarify the differences between the claimed invention and the prior art, and show that the claimed invention is patentably distinct over the prior art. Specifically, the Applicants' representative explained why *In re Larson* is not as relevant to the claimed invention of the present application as is *Schenck v. Nortron Corp.*, which thus, supports the patentability of the claimed invention. Applicants' representative further explained why MPEP § 2144.04 actually supports the position that the claimed invention is **not** obvious. Furthermore, Applicants' representative suggested adding the following claim language: "wherein the systems interface utilizes the gaming platform to produce enhanced system request capabilities and enable interactions with the system network that are not limited to discrete keypad type inputs for system requests."

**5. Examiner's Previous Arguments**

In paragraph 7 of the Office Action dated July 18, 2003, regarding claims 1, 16, 20, 41-43, 68, 69, 83, 84, 100-102, 114, 118, and 135-138, the Examiner stated that "integrating the systems interface into the gaming screen used to display gaming information" is well known in the art. In particular, the Examiner cites Walker et al. (U.S. 6,068,552) as showing a game screen display (210) that doubles as the game screen and the game customization screen, as shown in Fig. 3-6. The Examiner also cited several other patents in support of this position. The Applicants addressed these issues in the previous response, and these issues were not reasserted in the present Office Action. As such, the Applicants can only assume that these rejections have been withdrawn; however, the following response arguments have been restated again for the Examiner's convenience and to clarify that the claimed invention is patentability distinct over the cited references.

Applicants agree with the Examiner that Walker et al. (U.S. 6,068,552) shows a game screen display (210) which doubles as the game screen and the game customization screen.

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Applicants also agree that the other cited patents support the same position. However, this is not what is recited in the language of the claimed invention. Specifically, the Applicants have claimed a systems interface for displaying non-gaming system information through a gaming platform.

Walker et al. and the other references cited by the Examiner refer to gaming customization and other gaming related information. Claim 1 recites “a systems interface incorporated into the display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the display screen of the gaming platform.”

Accessing gaming information (such as game customization parameters) on the display screen of the gaming device is not a difficult or profoundly unusual task, since this gaming information is already resident in the gaming machine. Indeed, accessing gaming information on the display screen of the gaming device is a very different and far simpler task, than accessing non-gaming system information from a system network through the gaming platform using the display screen of the gaming device, as is claimed in the invention of the present application. Therefore, Applicants respectfully submit that these cited references do not support a 35 U.S.C. § 103(a) rejection of claims 1-138.

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CONCLUSION

Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the differences between the claimed invention and the prior art are such that the claimed invention is patentably distinct over the prior art. Therefore, reconsideration and allowance of all of claims 1-138 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific time.

Respectfully submitted,

Dated: \_\_\_\_\_

6/16/04

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